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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

WAGNER, ET AL.

Serial No.: **09/113,446**

Filed: **07/10/1998**

For: **HOUSING FOR PORTABLE
HANDHELD ELECTRONIC DEVICE**

Art Unit: **3624**

Examiner: **G. ANDERSON**

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Honorable Commissioner
for Patents
Washington, D.C. 20231

Attention: Board of Patent Appeals and Interferences

This is in reply to the Examiner's answer dated July 5, 2001.

As a preliminary matter, the Examiner's assertion that claims 6-11 stand or fall together is incorrect. 37 C.F.R. 1.192(c)(7) provides that the claims are grouped in accordance with the grounds of rejection. Claims within each group stand or fall together unless a statement is included to the contrary. However, there is nothing in the rule to suggest that the Examiner's grouping of the claims should be ignored and that all claims on appeal should stand or fall together.

As the Examiner acknowledges in his answer, three grounds for rejection are asserted.

Claims 6-8 are rejected under 35 U.S.C. § 102(b) based on Schmidt; claims 9-10 are rejected under 35 U.S.C. § 103(a) based on Schmidt in combination with Matone; and claim 11 is rejected under 35 U.S.C. § 103(a) based on Schmidt in combination with Mottmiller. Each ground of rejection must be separately decided based upon a single claim from the group.

Turning to the substance of the Examiner's Answer, Applicant maintains, with respect to claims 6-8, that the Schmidt reference fails to disclose "a one-piece, hollow body portion" as required by independent claim 6. Since Schmidt fails to disclose each and every element of the claimed invention, the rejection under 35 U.S.C. § 102(e) cannot be sustained.

The Examiner argues that: "Schmidt discloses upper and lower body parts which when secured to each other make the body portion. One could therefore say that the body portion of Schmidt is one piece of the scanner." By the Examiner's own admission, the body portion of Schmidt's scanner is made of at least two pieces. Clearly, this is not a "one-piece, hollow body portion" as recited in claim 6. One need only refer to the dictionary definition of "one-piece" cited in Applicant's Appeal Brief, i.e., "consisting of or made in a single undivided piece". Moreover, the specification of the subject application provides further definition of the meaning of "one-piece". As set forth in Applicant's Appeal Brief, page 4, lines 10-12 of the specification states that: "body portion 12 is made as a single part rather than as two joined halves. This eliminates the need for bonding or otherwise joining two halves and also eliminates the presence of an unattractive seam line."(emphasis added) This clearly distinguishes the claimed invention over the disclosure of Schmidt. As mentioned above, the Examiner expressly acknowledges that the body portion of Schmidt's scanner is made of upper and lower parts (i.e., two pieces) that are secured to each other. Since Schmidt does not disclose a "one-piece, hollow body portion" as such term is used in the claims on appeal, the rejection of claims 6-8 under 35 U.S.C. § 102(b) is improper and should be reversed.

Applicants' arguments with respect to claim group 2 (claims 9-10) and claim group 3 (claim 11) are not addressed in the Examiner's answer. For the reasons presented in the Appeal Brief, Applicant submits that the rejections of these claims under 35 U.S.C. § 103(a) are also improper and should be reversed.

Based on the record in this case, Applicant submits that all of claims 6-11 define patentable subject matter and respectfully requests that the Examiner's final rejection of these claims be reversed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP


George W Hoover
Reg. No. 32,992

Dated: September 5, 2001

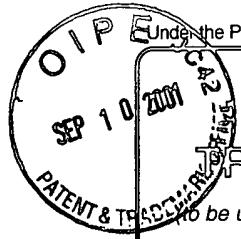
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		Application Number	09/113,446
		Filing Date	July 10, 1998
		First Named Inventor	Gregg Wagner RECEIVED
		Group Art Unit	3624
		Examiner Name	G. Anderson SEP 17 2001 3600 MAIL ROOM
Total Number of Pages in This Submission	13	Attorney Docket Number	3470P005

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Firm or Individual name	George W Hoover, Reg. No. 32,992 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
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Date	September 5, 2001

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Application Number	09/113,446
Filing Date	07/10/98
First Named Inventor	Gregg Wagner, et al.
Examiner Name	G. Anderson
Group Art Unit	3624
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2. CLAIMS Total Claims <input type="text"/> - <input type="text"/> X <input type="text"/> = <input type="text"/> Independent Claims <input type="text"/> - <input type="text"/> X <input type="text"/> = <input type="text"/> Multiple Dependent Claims Large Entity Small Entity Fee Fee Fee Fee Fee Description Fee Paid Code (\$) Code (\$) Code (\$) Code (\$)		Extra Fee from below Fee Paid 103 18 203 9 Claims in excess of 20 102 80 202 40 Independent claims in excess of 3 104 270 204 135 Multiple Dependent claim 109 80 209 40 Reissue independent claims over original patent 110 18 210 9 Reissue claims in excess of 20 and over original patent SUBTOTAL (2) (\$) <input type="text"/>	
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